



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,455	10/16/2003	David Rabe	10336/2	8737

27614 7590 11/28/2005

MCCARTER & ENGLISH, LLP
FOUR GATEWAY CENTER
100 MULBERRY STREET
NEWARK, NJ 07102

EXAMINER

WIEKER, AMANDA FLYNN

ART UNIT	PAPER NUMBER
----------	--------------

3743

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/687,455	Applicant(s) RABE, DAVID	
	Examiner Amanda F. Wieker	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 27-31 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-19 and 32 is/are allowed.
- 6) ☒ Claim(s) 1,2,6-11 and 20-26 is/are rejected.
- 7) ☒ Claim(s) 3-5 is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Group I in the reply filed on 08 July 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Applicant had cancelled non-elected claims 27-31 in the communication filed on 08 July 2005; however, in the instant communication Applicant indicates these claims as "withdrawn".
3. This application contains claims 27-31 drawn to an invention nonelected without traverse on 08 July 2005. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 6-7, 9 and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 4,862,900 to Hefe.

Regarding claims 1-2, 6, 9 and 11, Hefe discloses an ankle brace comprising:

a rigid U-shaped member (40) sized to fit under a foot, the U-shaped member having medial and lateral elements for extending along medial and lateral sides of a leg to support the inner and outer surfaces of an ankle and leg of an individual (see Figure 1);

Art Unit: 3743

inner (36) and outer (38) layers surrounding the rigid member and forming a body having a foot portion with a forward edge defining a toe aperture (22), and a footbed (14), and a leg portion with an upper edge (20), and rear edges (26, 32) extending from the upper edge (20) to the footbed (14), the body having side areas adjacent the medial and lateral elements of the U-shaped member and, a flexible front area (at 22; see crosshatching in Figures 1 and 2 and column 3, lines 44-60); and

a fastening strap (34) connectable about the body to retain the brace on the foot, ankle and leg of an individual. The footbed is sized to extend from the ball of the foot to the heel portion of a foot (see Figure 1). The ankle brace further comprises a leg cover (24) attached adjacent to a rear edge of the body for protecting the leg from the fastening strap (34). The ankle brace further comprises a cushion layer between the inner layer and the rigid member (see column 3, lines 61-64; cushion at inside surface of inner layer). The fastening strap (34) is secured with a hook-and-loop (VELCRO®) fastening system.

Regarding claims 20-23 and 25, Hefele discloses an ankle brace comprising: inner (36) and outer (38) layers forming a boot-shaped body having an open toe (22), an open back (32, 26) and a flexible heel (30); and a U-shaped support member (40) positioned between the inner and outer layers which extends along the bottom of a foot from the ball of the foot to the front of the flexible heel and up the sides of the boot-shaped body to support the inner and outer surfaces of the ankle and lower leg of an individual, wherein when positioned on a person, the flexible heel is positioned under a heel of a person's foot (see Figure 1). The ankle brace further comprises a means for securing (34) the brace to the leg. The means for securing the brace to the leg comprises an adjustable strap (VELCRO®). The ankle brace further comprises a cushion layer between the inner layer and the support member (see column 3, lines 61-64; cushion at inside

Art Unit: 3743

surface of inner layer). The brace comprises a flexible heel portion (30) having inner (36) and outer (38) layers, and a cushion layer therebetween (see column 3, lines 61-64; cushion at inside surface of inner layer).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8, 10 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hefe in view of U.S. Patent Application Number 6,155,997 to Castro.

Hefe disclose the previously described ankle brace comprising an inner layer, an outer layer, and a rigid support member sized to fit between the inner and outer layers. Hefe further discloses the presence of a cushion layer on the inner surface of the inner layer. Hefe does not specify that the cushion layer comprise foam, or that the inner and outer layers comprise leather.

Castro discloses a multi-layer ankle brace comprising an inner layer (152), an outer layer (166), and a rigid support member (160) sized to fit between the inner and outer layers. Castro further discloses the presence of a cushioning foam layer (158) on the inner surface of the inner layer, between the inner layer and the rigid member. Castro specifies that such materials provide sufficient patient comfort without loss of support (see column 3, lines 66-67). Castro also discloses a relatively flexible heel portion, wherein the heel portion includes the inner layer, outer layer and foam, but does not include the rigid support member (see Figure 5).

Art Unit: 3743

It would have been obvious to one skilled in the art at the time the invention was made to have provided the ankle brace disclosed by Hefele, wherein the cushion layer comprises foam, and the inner and outer layers comprise leather, as taught by Castro, to provide sufficient patient comfort without loss of support.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hefele in view of U.S. Patent Application Number 5,720,715 to Eriksson.

Hefele disclose the previously described ankle brace comprising an inner layer, an outer layer, and a rigid support member sized to fit between the inner and outer layers. Hefele does not specify that the rigid support member comprise plastic.

Eriksson discloses a multi-layer ankle brace comprising an inner layer (27), an outer layer (26), and a rigid support member (11) sized to fit between the inner and outer layers. Eriksson specifies that the rigid support member be a thermoplastic material to allow custom adjustment of the rigid member to the specific patient (see column 3, lines 52-56).

It would have been obvious to one skilled in the art at the time the invention was made to have provided the ankle brace disclosed by Hefele, wherein the rigid support member comprises a plastic material, as taught by Eriksson, to allow custom adjustment of the rigid member to the specific patient.

Allowable Subject Matter

9. Claims 12-19 and 32 are allowed.

10. Claims 3-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed 08 November 2005 have been fully considered but they are not persuasive.

12. Regarding claim 1, Applicant argues that Hefele does not disclose a "flexible front area". The examiner disagrees. As seen in Figure 1-2 and at column 3, lines 50-60, Hefele shows a flexible area at the front of the foot, at region 22 where "the reinforcement layer 40 is omitted in the areas of the flaps 24 and along the edges bordering the front opening 22" and states that the "remaining areas not covered by the reinforcement layer are somewhat flexible, so that they can adapt to the contours of the human's leg."

Clearly, this area at region 22, which lacks reinforcement layer 40, constitutes a "flexible front area" as claimed.

13. Regarding claim 20, Applicant argues that Hefele does not disclose a "flexible heel" that if "positioned under a heel of a person's foot". The examiner disagrees. As seen in Figure 1-2 and at column 3, lines 50-60, Hefele shows a flexible area at the heel of the foot, at region 30 where "the reinforcement layer 40 is omitted in the areas of ...the heel opening" and states that "the remaining areas not covered by the reinforcement layer are somewhat flexible, so that they can adapt to the contours of the human's leg."

Clearly this region 30 constitutes a flexible heel, and as seen in Figure 1, it is positioned under the heel of the person.

14. Applicant's arguments, see page 12, filed 08 November 2005, with respect to the amendment to claim 12 have been fully considered and are persuasive. The rejection of claim 12 has been withdrawn.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda F. Wieker whose telephone number is 571-272-4794. The examiner can normally be reached on Monday-Thursday, 7:30 - 5:00 and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


afw

Amanda F. Wieker
Examiner
Art Unit 3743


Henry Bennett
Supervisory Patent Examiner
Art Unit 3700